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09/873,522	06/04/2001	Richard E. Scordato	M1005/7006 RJK	3542

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EXAMINER

GORDON, BRIAN R

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 06/17/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/873,522

Applicant(s)

SCORDATO ET AL.

Examiner

Brian R. Gordon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-29 is/are allowed.
- 6) ☒ Claim(s) 1,2,5,9-18,21-24,30 and 31 is/are rejected.
- 7) ☒ Claim(s) 3,6-8,19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5-6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Drawings***

1. Figures 6A and ^B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 15. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. Claim 6 objected to because of the following informalities: In appears as if the word "operation" in the last line should be "operator". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 4-5, 9, 11-17, 21, 23-24, and 30-31 rejected under 35 U.S.C. 102(b) as being anticipated by Andrews, Jr. et al. US 3,954,014.

Andrews, Jr. et al. disclose a device is disclosed for receiving a disposable pipette tip, aspirating a supply of liquid into the pipette and dispensing the liquid in precise predetermined dosages. The device comprises a housing, a cylindrical passage within the housing, a piston extending into the passage from the rear end thereof and a plunger extending rearwardly from the piston. Actuating means are disposed within the housing for advancing the plunger forward in discrete amounts and a trigger extends from the housing operatively engaging the actuating means. The device further includes means for disengaging the actuating means whereby the plunger may freely be moved forward and back to permit a supply of liquid to be aspirated into the pipette. A detipping mechanism is also provided which permits a pipette tip to be removed without requiring any handling of it.

As seen in Figures 1 and 7 the nozzle 30 of the device appears to be extended downward (relative to the central axis of the housing) at an angle between the range of 60-80 degrees as specified by the claims.

Another important feature of the invention is the ejector arrangement 90 provided to automatically remove pipettes from the housing when desired. Ejector 90 comprises a wire 92 extending about the forward portion of the housing and having a loop 94 immediately behind the nozzle step 86. The wire is formed with a pair of wings 96 and

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98 on opposite sides of the housing with each wing terminating in a post 100 extending into a suitable opening in the housing front end. When either of the wings is pushed upwardly or downwardly, the loop 94 moves eccentrically forward thereby urging the pipette off the nozzle step 86 and enabling it to fall freely of the assembly.

As to the angle at which the device is held, the operator is allowed to hold the device at any angle to suit his/her personal use or desire. The angle at which the device is held does not limit the use of the device. The device would still function as designed to aspirate and dispense at any angle.

As to the recitation of "a body portion shaped to fit in an operator's hand", for the purpose of examination the examiner has interpreted the recitation as the a portion the pipette that allows for a user to hold and use the pipette in one hand.

As to the base being stable, the base may be stable depending on how the device is arranged or stored. The base may allow the device to be stable when stored in a particular holder.

6. Claims 1-2, 4-5, 9, 11-17, 21, 23-24, and 30-31 rejected under 35 U.S.C. 102(b) as being anticipated by Berman et al. US 3,786,683.

Berman et al. disclose a hand-operated portable pipette is disclosed which includes a housing, a flexible tube mounted therein along a path. The tube has a first end thereof mounted for movement with respect to the housing. A trigger is also mounted on the housing to operate a roller for occluding the tube along a portion of the path in response to movement of the trigger. The trigger is biased to a rest position. A multifaced cam is mounted as an adjustable stop for determining the nominal maximum

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travel of the trigger. A spring loaded over-travel stop is mounted in the trigger to interact with the multifaced cam so that a first force applied to the trigger will cause the spring loaded over-travel stop to rest against the face of the multifaced cam bringing the trigger to rest at a first position. If additional force is applied to the trigger, the spring loaded over-travel stop depresses into the trigger extending the movement of the trigger to allow the tube to be occluded further along the path. A disposable tip is inserted in a movable end of the tube to allow changing thereof. A second trigger, arm, and sleeve are used to eject the disposable tip after usage.

As seen in Figure 1 the nozzle 30 of the device appears to be extended downward (relative to the central axis of the housing) at an angle between the range of 60-80 degrees as specified by the claims.

As to the angle at which the device is held, the operator is allowed to hold the device at any angle to suit his/her personal use or desire. The angle at which the device is held does not limit the use of the device. The device would still function as designed to aspirate and dispense at any angle.

As to the base being stable, the base may be stable depending on how the device is arranged or stored. The base may allow the device to be stable when stored in a particular holder.

7. Claims 1-2, 4, 9, 11-13, 16-18, 21, 23-24, and 30-31 rejected under 35

U.S.C. 102(b) as being anticipated by Tervamaki et al. US 4,690,005.

8. Tervamaki et al. disclose a diluting dosage device, in which there is a dilution-liquid cylinder (20), a sample cylinder (30), a press knob (2), and a blocking valve (21).

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When the knob is depressed, the blocking valve is closed and the pistons (16 and 15) in the cylinders move rearwards, whereat dilution liquid flows into the dilution-liquid duct (2), and a certain quantity of sample into the sample duct (23). When the press knob is returned, the blocking valve is opened and the pistons push the sucked sample and a certain quantity of the dilution liquid out through the tip (7).

At the end of the adjustment shaft 12, there is a detachable adjustment knob 39 (removable button), which is fitted non-rotably relative the adjustment shaft. By means of the adjustment knob 39, it is, thus, possible to rotate the adjustment shaft 12, whereby the nut 14 is shifted along the shaft accordingly. When the adjustment knob 39 is pulled out, it is possible to rotate the calibration nut 41 and thereby to set the front limit of the movement of the piston exactly at the desired position.

The device also comprises a removable storage bottle 6 (removable bottom).

As seen in Figures 1 and 5A the nozzle 30 of the device appears to be extended downward (relative to the central axis of the housing) at an angle between the range of 60-80 degrees as specified by the claims.

As to the angle at which the device is held, the operator is allowed to hold the device at any angle to suit his/her personal use or desire. The angle at which the device is held does not limit the use of the device. The device would still function as designed to aspirate and dispense at any angle.

As to the base (stand 41) being stable, the base may be stable depending on how the device is arranged or stored. The base may allow the device to be stable when stored in a particular holder or standing alone.

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9. Claims 1-2, 4, 9, 11-13, 15, 17, 21, 23-24, and 30-31 rejected under 35 U.S.C. 102(e) as being anticipated by Feygin US 6,524,531.

Feygin discloses a hand-held, single-channel dispenser/aspirator is disclosed. The present dispenser/aspirator comprises a body portion for gripping the dispenser and a head portion. In some embodiments, the head portion includes a valve, a liquid conduit and a removable liquid reservoir. The liquid conduit places the liquid reservoir and the dispensing valve in fluid communication. A gas conduit received by the body portion of the dispenser is operable to pressurize the fluid reservoir, or draw a partial vacuum therein. Controls located on the body portion operate the dispenser. The liquid reservoir is advantageously disposed near the valve, so that a relatively short length of liquid conduit is required to operatively connect the reservoir and the dispensing valve, thereby improving the accuracy of the dispensing operation.

Body portion 104 of illustrative dispenser 100 provides a means for a user to grip the dispenser for use. Power source 122, which supplies power for actuating dispensing valve 106, is electrically connected to dispensing valve 106 via lead 118 through button 120. Button 120 (on the top to be operated by ones thumb), which is actuated by a user's finger, sends a signal to power source 122, which responds by sending a voltage pulse of preset length that defines the opening time of dispensing valve 106. In an aspirating mode (described below), power source 122 sends a group of pulses to dispensing valve 106 so that it remains open.



As seen in Figure 1 the nozzle 30 of the device appears to be extended downward (relative to the central axis of the housing) at an angle between the range of 60-80 degrees as specified by the claims.

As to the angle at which the device is held, the operator is allowed to hold the device at any angle to suit his/her personal use or desire. The angle at which the device is held does not limit the use of the device. The device would still function as designed to aspirate and dispense at any angle.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andrews, Jr. et al., Berman et al., Tervamaki et al.

Although the prior art does not specifically recite the required pressure needed to actuated the triggers of the devices, It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a trigger that required an optimal minimum actuation pressure in order to reduce the occurrence of spillage or inaccurate dispensing or aspirating that may occur if the it is too difficult to press the trigger.

***Allowable Subject Matter***

14. Claims 25-29 are allowed.

15. Claims 3, 6-8, and 19-20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baba et al., Kohrmann et al., Kenny (,791 and ,968), Homberg et al., Oshikubo, Marteau D'Autry, Gomes, Evans et al., Labriola, Burg, Eckert, Bilbrey et al., Metsala, and Pepicelli et al. disclose hand held pipettes.

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17. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach nor fairly suggest a device that comprises a nozzle with an adjustable angle, a hook extending from a point on said body portion which is sufficiently angularly spaced from the point from which said nozzle extends to permit the hook to fit over a selected portion of the operator's hand when the pipette is being held by the operator in a position for use, an adapter selectively mountable to said body portion, said adapter adjusting the size of said body portion to better fit operator hand size, and a padding on at least a portion of said body portion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is (703) 305-0399. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

brg  
June 12, 2003

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700